

Restriction Requirement

The Examiner has issued a Restriction requirement under 35 U.S.C. 121 that the Applicant elect a single disclosed species for prosecution on the merits. Applicant hereby affirms the May 11, 2004 provisional election without traverse to prosecute the invention of Group I and species a (claims 1-10).

REMARKS

Entry of the foregoing and further and favorable reconsideration of the subject application in light of the foregoing amendment and the following remarks:

Applicant respectfully submits that no new matter has been added.

Claims 1-11 were pending at the time the June 17, 2004 Office Action was issued.

Claim 11 is now withdrawn.

Claims 2,4 and 7 are cancelled.

New Claims 12-18 are added.

Claims 1 and 3 have been amended. Support for the amended claims can be found generally throughout the instant Specification. No new matter has been added.

Accordingly, Claims 1,3,5,6,8-10, and 12-18 are pending.

35 U.S.C. § 112, First Paragraph.

On page 3 of the June 17 2004 Office Action, Claims 1-10 are rejected under 35 U.S.C § 112 first paragraph in that the claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Specifically, the Examiner asserts that Claim 1 is deemed to contain new matter in regards to the limitation: “wherein the polyethylene oxide has a molecular weight greater than 250,000.”

In response, support for Claim 1 as presently amended, can be found in the specification as originally filed in the parent application 09/751,160 on page 6, line 1 and page 13, line 16. Accordingly, the Applicant respectfully requests that the Examiner withdraw the rejection.

35 U.S.C. § 102(b) and 35 U.S.C. § 103(a).

On pages 4-5 of the June 17, 2004 Office Action, Claims 1-3 and 8 are rejected under 35 USC § 102 as anticipated by or in the alternative, USC § 103 as obvious over Roth, US Patent No. 5,418,006. The Examiner notes “Roth et al may differ from applicant’s claimed invention in that it is unclear what the molecular weight is of the carboxymethylcellulose used in Examples 4-5. However, the Examiner asserts that it would be obvious for one of skill in the art to use the range as claimed by the applicant. On pages 5-6 of the June 17, 2004 Office Action, the Claim 4-7 are rejected as obvious over Roth. The Examiner notes that Roth does not teach removal of the coating as taught by the presently claimed invention, but asserts that the broad disclosure of Roth renders such a teaching obvious.

Applicant respectfully submits that Roth teaches a multi-step process of first treating a substrate with an impregnating agent which renders the substrate water repellent, and subsequently forming a coating by applying to the treated surface an aqueous composition containing an aqueous solution, dispersion and/or emulsion of a film-forming substance and a water-repellent substance. The present invention is distinct in both its approach and process. Indeed, Roth, in its “impregnation” step teaches away from the present invention. Indeed, examination of Roth’s Example 4 clearly reveals a pre-requisite impregnation step (“with a

silicon solution”). Moreover, Roth, in Example 4, teaches post-impregnation treatment using a solution “mixed with, in each case, 3.0 parts of a paste which contains 40% by weight of fluorinated polyurethane.” Roth teaches away, as exemplified by way of Example 4, from the approach of the present invention. Indeed, one of skill in the art as taught by Roth, would expect that the polyurethane component renders a post-impregnated treatment water repellent. Throughout the Roth patent, Roth teaches a requisite impregnation step and a required water-repellent.

Accordingly, Applicant respectfully submits that the claims as presently amended overcome the rejections under 35 U.S.C. § 102 as anticipated by or in the alternative § 103 as obvious over Roth.

On pages 6-7 of the June 1, 2004 Office Action, the Examiner rejects Claims 1,4-6 and 8-10 under 35 U.S.C. §102(b) as anticipated by or in the alternative under 35 U.S.C. §103(a) as obvious over Murayama U.S. Patent No. 5,401,495. On page 7 of the June 17, 2004 Office Action, the Examiner also rejects Claim 7 under 35 U.S.C. § 103(a) as being unpatentable over Murayama, asserting that it would have been notoriously obvious to apply addition amounts of the composition to a surface. The Examiner notes that Murayama may differ from applicant’s claimed invention in that it is unclear what the molecular weight is of the carboxymethylcellulose 7MF component used in Example 4. However, the Examiner asserts that it would be obvious for one of skill in the art to use the range as claimed by the applicant, since such a molecular weight range is deemed to come directly within the broad disclosure of the patent.

In response, the Applicant respectfully submits that the claims as presently amended overcome the rejections under 35 U.S.C. 102(b) and 35 U.S.C. § 103(a) over the cited prior art. Specifically, Murayama does not teach the invention as now claimed. Murayama teaches a teeth whitener composition, which “has the ultimate effect of ‘staining’ the teeth white by absorption.” Murayama at column 6, line 45-46. This composition, which is not removable, functions to “bleach” the teeth by absorbing titanium dioxide particles into the enamel of the teeth. The instant invention as now claimed is a composition, which can be removed from the surface at about room temperature with a solvent, which is distinct from the cited prior art reference.

Accordingly, Applicant respectfully submits that the amended application is not anticipated or rendered obvious by the cited prior art references and urges the Examiner to withdraw the rejection of claims 1,4-6 and 8-10 under 35 U.S.C. 102(b) as anticipated by Murayama or in the alternative under 35 U.S.C. §103(a) as obvious over Murayama and claim 7 under 35 U.S.C. §103(a) over Murayama.

On pages 7-8 of the June 15, 2004 Office Action, claims 1-10 are rejected under 35 U.S.C. §103(a) as unpatentable over Sramek U.S. Patent No. 4,861,583. The Examiner notes that Sramek differs from applicant’s claimed invention in that there is no direct teaching to a method of using a hair treatment composition that actually comprises a water soluble polyethylene oxide that has a molecular weight of greater than 250,000. However, the Examiner asserts that it would be obvious for one of skill in the art to make and use a hair treatment composition that contained a water-soluble polyethylene oxide polymer having a molecular weight greater than 250,000 since Sramek directly discloses and claims the use of polyethylene oxide within a range of between 20,000 and about 250,000. The Examiner asserts that Sramek’s

use of the modifier “about” clearly expands Sramek’s disclosure to encompass a range “somewhat in excess of 250,000.

In response, the Applicant respectfully submits that the claims as presently amended overcome the rejections under 35 U.S.C. § 103(a) over the cited prior art. Specifically, Sramek does not teach the invention as now claimed. Moreover, the invention as now claimed involves a composition, which can be removed from the surface at about room temperature with a solvent, which is distinct from the cited prior art reference.

Applicant respectfully submits that the amended application is patentable over Sramek under 35 U.S.C. 103(a) because it would not have been obvious to one having ordinary skill in the art to use the disclosure of Sramek as motivation to make the claimed composition which is capable of being removed from the surface at room temperature. There is no direct teaching in the cited prior art reference of the instant invention as now claimed. Moreover, there is no suggestion in the cited prior art reference to do so.

Accordingly, Applicant respectfully submits that the amended application is not rendered obvious by the cited prior art reference and urges the Examiner to withdraw the rejection of claims 1-10 35 U.S.C. 103(a) over Sramek.

Applicant respectfully submits that Rejections cited in paragraphs 11-15 of the June 15, 2004 Office Action are unsupported in view of the presently amended claims. Applicant has responded by describing the referenced patents and how they differ from and fail to teach the Applicant’s invention. The descriptions of referenced patents follow the legal references forming the basis for allowance under 35 U.S.C. Applicant has amended the claims so as to overcome the rejections under 35 U.S.C. 102(b) and 35 U.S.C. 103 (a).

With regard to any proposed combination of the cited prior art references, it is well known that in order for any prior art references themselves to be validly combined for use in a prior art §103 rejection, the references themselves (or some other prior art) must suggest that they be combined. In re Sernaker, 217 U.S.P.Q. 16 (CAFC 1983).

Prior art references in combination do not make an invention obvious unless something in the prior art references would suggest the advantage to be derived from combining their teachings. The suggestion to combine the references should not come from applicant. Orthopedic Equipment Co. v. United States, 217 U.S.P.Q. 193, 199 (CAFC 1983); Uniroyal, Inc. v. Rudkin-Wiley Corp., 5 U.S.P.Q. 2d 1434 (C.A.F.C. 1988) (“where prior-art references require selective combination by the court to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself...Something in the prior art must suggest the desirability and thus the obviousness of making the combination.”).

CONCLUSION

For the foregoing reasons, Applicant respectfully submits that the application and amended claims are now in proper form for allowance and that the amended claims are patentable over the prior art.

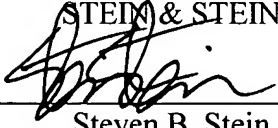
Therefore, Applicant respectfully submits that the application is now in condition for allowance, namely Claims 1,3,5,6,8-10, and 12-18.

If for any reason this application is not believed to be in full condition for allowance, applicant respectfully requests the constructive assistance and suggestions of the Examiner

pursuant to M.P.E.P. 706.03(d) and 707.07(j) in order that the undersigned can place this application in allowable condition as soon as possible without the need for further proceedings.

In the event that there are any questions concerning this Amendment, or the application in general, the Examiner is respectfully urged to telephone the undersigned so that prosecution of the application may be expedited.

No fee, other than the \$510.00 fee for a three-month extension of time, is deemed necessary in connection with the filing of this Amendment.

Respectfully submitted,
STEIN & STEIN
By:  12/17/2004
Steven B. Stein
Reg. No.: 43,159

STEIN & STEIN
114 Old Bloomfield Ave.
Parsippany, NJ 07054
(973) 882-8820

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